

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Customer Number: 46320  
Frank LEYMAN, et al. : Confirmation Number: 5078  
Application No.: 10/042,799 : Group Art Unit: 2157  
Filed: January 9, 2002 : Examiner: A. Gold  
Appeal No. 2008-1050 :  
For: MANAGING A FAILURE TO ACCESS A DATABASE IN A  
COMPUTER SYSTEM

**REQUEST FOR REHEARING**

Mail Stop Appeal Brief - Patents  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing is submitted under 37 C.F.R. § 41.52 in response to the Decision on Appeal dated September 24, 2008 (hereinafter the Decision). This Request for Rehearing is timely filed within the two month time period for reply set forth under 37 C.F.R. § 41.52(a)(1).

Appellants respectfully submit that in the Decision on Appeal, the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellants in the Appeal Brief of November 22, 2006, and in the Reply Brief of August 14, 2007. Appellants will specifically identify these particular points below.

## REMARKS

Decisions of the PTO tribunals are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. § 706, to appeals of PTO rulings). Thus the Board's factual findings are reviewed to determine whether they are unsupported by substantial evidence, and the Board's conclusions are reviewed for correctness in law. See In re Gartside, 203 F.3d 1312 (Fed. Cir. 2000).

In the last two full paragraphs on page 6 of the Decision, the Honorable [REDACTED] made the following assertions:

Accordingly, the issue is whether Helmer discloses "sending a request of the application client for the first application server from the first application server to the second application server while the first one of the two application servers fails to access the database" (Claim 1).

We agree with the Examiner’s finding that Helmer discloses such claimed limitation beginning at page 5 of the Answer, and the Examiner’s corresponding responsive arguments beginning at page 7 of the Answer.

21 At the outset, Appellants note that the Honorable Board mischaracterized the  
22 Examiner's analysis and findings. At no point during prosecution has the Examiner  
23 asserted that Helmer discloses "sending a request of the application client for the

1 first application server from the first application server to the second application  
2 server while the first one of the two application servers fails to access the  
3 database."

4

5 Referring to paragraph spanning pages 4 and 5 of the Examiner's Answer,  
6 the Examiner is relying upon the combination of Holmberg and Rizvi to teach the  
7 limitation of "a failure to access a database." The first two full paragraphs on page  
8 5 of the Examiner's Answer are reproduced below:

9 Holmberg and Rizvi fail to teach the limitation further including sending a  
10 request of the application client (15) for the first application server (21) from the  
11 first application server (21) to the second application server (20).

12 However, Helmer teaches a geographic data replication system and  
13 method for a network (see abstract). Helmer teaches the use of a failed server  
14 routing requests to a remote server for processing (col. 2, lines 2-15, 46-59).

15

16 Completely absent from the Examiner's analysis with regard to Helmer is  
17 any mention of Helmer being used to teach the claimed "while the first one of the  
18 two application servers fails to access the database."

19

20 Referring to second full paragraph on page 8 of the Examiner's Answer, the  
21 Examiner asserted the following:

22 The Appellant argues Helmer does not teach a failed server routing  
23 requests to a remote server and reproduces the column and line numbers, column

1       2, lines 2-15 and column 2, lines 46-59, from the Examiner's rejection in their  
2       appeal brief. The limitation in question is explicitly shown in both sections in  
3       column 2 on lines 11-13, "If a server fails, such as the local server, the remote  
4       server begins processing user requests based on the temporary data it received  
5       from the local server." and lines 53-54, "If the local server fails, the user request is  
6       routed to the remote server." As disclosed in these passages, Helmer clearly  
7       teaches "a failed server routing requests to a remote server."

8  
9       Also absent from this passage is any discussion by the Examiner, while  
10      characterizing the teachings of Helmer, of the claimed "while the first one of the  
11      two application servers fails to access the database."

12  
13      Therefore, for the reasons presented above, Appellants respectfully submit  
14      that the Honorable Board has mischaracterized the Examiner's analysis and  
15      findings by asserting that the Examiner has made a finding of fact that Helmer  
16      discloses "sending a request of the application client for the first application server  
17      from the first application server to the second application server while the first one  
18      of the two application servers fails to access the database." For reasons that will be  
19      discussed in greater detail below, this mischaracterization of the teachings of  
20      Helmer has caused the Honorable Board to misapprehended and/or overlook two  
21      sets of arguments presented by Appellants in the Appeal and Reply Briefs.

1        Although the Examiner has not asserted that Helmer discloses "sending a  
2    request of the application client for the first application server from the first  
3    application server to the second application server while the first one of the two  
4    application servers fails to access the database," Appellants recognize that  
5    Honorable Board's characterization of the teachings of Helmer could be  
6    intentional.

7

8        If so, designation as a new ground is necessary because Appellants have not  
9    had a fair opportunity to react to the thrust of the "affirmance" of the rejection,  
10   which is based upon a characterization of the prior art that was not relied on by the  
11   Examiner. See In re Kumar, 418 F.3d 1361, 1367-68 (Fed. Cir. 2005) ("the  
12   ultimate criterion of whether a rejection is considered 'new' in a decision by the  
13   board is whether appellants have had fair opportunity to react to the thrust of the  
14   rejection") (quoting In re Kronig, 539 F.2d 1300, 1302 (CCPA 1976)). In the  
15   present situation, Appellants have not have had a fair opportunity to react to the  
16   assertion that Helmer discloses the entire limitation of "sending a request of the  
17   application client for the first application server from the first application server to  
18   the second application server while the first one of the two application servers fails  
19   to access the database." Appellants have already addressed the first part of the  
20   limitations, but have not had the opportunity to address the assertion that Helmer

1 teaches "while the first one of the two application servers fails to access the  
2 database."

3

4 As to the limitations of "while the first one of the two application servers  
5 fails to access the database," a textual search of Helmer fails to yield even a single  
6 instance of the word "database." Helmer, however, does refer to file servers 16A,  
7 16B, which could be considered a database. Regardless, Helmer does not teach  
8 that an application server (presumably corresponding to utility servers 18A, 18B)  
9 failing to access a file server 16A, 16B). Instead, referring to column 7, lines 20-  
10 43, Helmer teaches that the data center 14A/14B becomes "unavailable" or "fails."  
11 As such, Helmer does not teach the limitation of "while the first one of the two  
12 application servers fails to access the database."

13

14

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15 In the first two full paragraphs on page 7 of the Decision, the Honorable  
16 Board asserted the following:

17 Helmer discloses that, when a local server fails, the user requests  
18 **processed by the failed data center are routed to the remote server (using any**  
19 **routing technique)**, and the remote server begins processing user requests based  
20 on the temporary data it **received from the local server (FF 1)**. The Examiner  
21 finds that "Helmer clearly teaches 'a failed server routing requests to a remote  
22 server'" (Ans. 8). We generally agree.

1           We find that Helmer clearly teaches that the remote server receives data  
2       (such as temporary data) from the local server, and that the user requests that are  
3       processed by the failed local server are routed to the remote server (FF 1). Thus,  
4       we find that Helmer teaches, or at the least, strongly suggests, that the request is  
5       sent from the failed local server (that processed the request) to the remote server.  
6       In fact, an artisan would have understood that it would have been obvious to  
7       select the local server as the server from which to send the request that it  
8       processed, to the remote server, because the remote server regularly receives data  
9       from the local server, and the artisan is a person of ordinary creativity, not an  
10      automaton. *See KSR*, 127 S. Ct. at 1742. We find that such sending of the request  
11      from the local server is merely simply incorporating the local server to perform  
12      the same function it had been known to perform, yielding merely expected results,  
13      and thus, such incorporation is obvious. *See KSR*, 127 S. Ct. at 1740. (bold in  
14      original, underlined added)

15  
16       Based upon the Honorable Board's statement that "Helmer teaches, or at the  
17       least, strongly suggests, that the request is sent from the failed local server," the  
18       Honorable Board does not appear to be entirely convinced that Helmer explicitly  
19       teaches the request is sent from the failed local server to the remote server.

20  
21       The Examiner and the Honorable Board has relied upon the teaching of  
22       "using any routing technique" from column 7, line 37 of Helmer. However, as  
23       argued in the paragraph spanning pages 5 and 6 of the Reply Brief, Helmer is silent  
24       as to the entity performing the routing of the user request to the remote server. As

1 claimed, the server (while failing to access the data) is required to route the  
2 request.

3

4 Moreover, as also argued in the Reply Brief, within the same sentence of  
5 Helmer that the statement "using any routing technique" is found, Helmer teaches  
6 using the routing technique described in U.S. Patent Application No. 09/021,091  
7 (issued as U.S. Patent No. 6,735,631). As described therein, a redirector 16  
8 changes the destination address of a user request to redirect the user request to one  
9 of a plurality of application server 12a, 12b. The redirector 16 is also described as  
10 also using this technique for failover. Therefore, based upon the only explicit  
11 teaching provided, Helmer does not teach that the first application server routes  
12 requests to the second application server, as claimed. Instead, Helmer teaches the  
13 use of a redirector 16, which is separate from an application server, that provides  
14 the routing.

15

16 Referring to the underlined passage of the above-reproduced assertions from  
17 the Decision, the Honorable Board asserted that "sending of the request from the  
18 local server is merely simply incorporating the local server to perform the same  
19 function it had been known to perform, yielding merely expected results, and thus,  
20 such incorporation is obvious." These assertions were not previously presented by

1 the Examiner. As such, Appellants have not had a fair opportunity to react to the  
2 thrust of the "affirmance" of the rejection.

3

4       Although Appellants are reluctant to give any particular argument more  
5 importance than other arguments, the next set of arguments are **extremely**  
6 **important** in clarifying (i) why Helmer does not teach using the failed server to  
7 forward to request or why such a teaching would have been obvious. Specifically,  
8 the assumption that the local server "perform[s] the same function it had been  
9 known to perform, yield merely expected results" is factually incorrect.

10

11       Helmer clearly and unambiguously states that the local server has "**failed**"  
12 (see column 7, line 35, "[i]f one data center 14A or 14B fails") and/or is  
13 "**unavailable**" (see column 7, lines 23-25, "[i]f data center 14A becomes  
14 unavailable" and column 7, lines 28-29 "[w]hen data center 14A is not available").  
15 Thus, based upon the teachings of Helmer that the local data center has "failed"  
16 and/or is "unavailable," the local data center does **not** perform the same functions it  
17 had been known to perform. Since the local data center cannot perform the same  
18 functions it had been known to perform (i.e., the processing of the request), one  
19 having ordinary skill in the art would recognize that the local data center is very

1 likely also incapable of not performing other functions that the local data center  
2 had previously been capable of performing.

3

4 The reasoning behind this is firmly grounded in common sense. For  
5 example, if the local data center has failed/is unavailable because a power supply  
6 serving the local data center has gone bad, the local data center would be incapable  
7 of performing any function. Similarly, the local data center may have  
8 failed/become unavailable because the switch 22A/22B is inoperative, in which  
9 instance, the local data center cannot communicate with any entity (including the  
10 remote server), and thus, the local data center cannot forward the request to the  
11 remote server. Based upon these and a multitude of other possible examples why  
12 the local data center may have failed/become unavailable, one skilled in the art  
13 would recognize that the other functions that the local data center was previously  
14 capable of performing are also likely not available when the local data center is  
15 being characterized as failed/unavailable.

16

17 The Honorable Board asserts that Helmer strongly suggests that the request  
18 is sent from the failed local server to the remote server. Appellants respectfully,  
19 yet vigorously disagree. In fact, Helmer strongly teachings the use of a redirector  
20 to route the requests during failover, which does not support the Honorable Board's

1 assertion. Moreover, this use of a redirector for routing is a common sense  
2 approach that would be readily adopted by one skilled in the art for obvious  
3 benefits. Specifically, since the local data center has failed/is unavailable, relying  
4 upon the local data center to route the request to the remote data center would incur  
5 the substantial risk that the request would never be forwarded to the remote data  
6 center. However, by employing a redirector, as explicitly taught by Helmer, the  
7 request would be forwarded using a component (i.e., the redirector) that has not  
8 been deemed failed/unavailable, as with the data center. As such, Appellants  
9 respectfully submit that the obvious combination based upon the teachings of  
10 Helmer would employ a redirector to route the request to the remote data center so  
11 as to ensure that the remote data center actually received the request.

12

13

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14 On page 8, lines 4-7 of the Decision, the Honorable Board asserted the  
15 following:

16 We find that such routing of the user request when the local server fails of Helmer  
17 occurs in various situations *including while* the local server fails to access the  
18 database. (emphasis in original).

19

20 As noted above, the Honorable Board's factual findings are reviewed to determine  
21 whether they are unsupported by substantial evidence. In this instance, the  
22 Honorable Board's finding that the routing of a user request, when the local server

1 fails, occurs while the local server fails to access the database is entirely  
2 unsupported by substantial evidence. Neither the Examiner nor the Honorable  
3 Board has ever pointed to a specific explicit teaching within Helmer to support  
4 such a finding. Thus, the Honorable Board's finding is not supported by substantial  
5 evidence.

6

7

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8 On page 8, lines 7-9 of the Decision, the Honorable Board asserted the  
9 following:

10 In fact, an artisan would have understood that the routing occurs while the local  
11 server fails since the purpose of the Helmer invention is for the remote server to  
12 process the data when the local server fails.

13

14 Appellants do not disagree with this characterization of the teachings of Helmer.  
15 However, these teachings do not lead to the claimed invention. These teachings  
16 discuss the importance of routing the request to the remote data center. However,  
17 the claimed invention is not directed to "routing," in general. Instead, the claimed  
18 invention is directed to a specific type of routing. Moreover, Helmer teaches a  
19 specific type of routing (i.e., the teachings of U.S. Patent No. 6,735,631, which  
20 was cited by Helmer) which can be performed by a redirector (and not the local  
21 data center).

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2

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3       On page 8, lines 9-14 of the Decision, the Honorable Board asserted the  
4 following:

5       Contrary to Appellants' argument that the Examiner "failed to put forth a realistic,  
6 common sense rationale," we find that such routing of the request while the server  
7 fails is merely the server performing the same function that it has been known to  
8 perform, yielding expected results. Thus, we find that the subject matter as a  
9 whole would have been obvious to the artisan.

10  
11      Although Appellants have addressed this assertion when it was made on page 7 of  
12 the Decision, Appellants will address other aspects of this assertion in greater  
13 detail.

14  
15      At the outset, Appellants note that, within the Decision, the Honorable  
16 Board has essentially ignored the Examiner's asserted motivation for making the  
17 proposed combination (i.e., "[a] faster and more efficient way to send a request  
18 from the first server to the second server"). Instead, the Honorable Board is  
19 relying upon a different analysis. Although not explicitly stated, the Honorable  
20 Board appears to be relying upon Rationale B (i.e., "Simple Substitution of One  
21 Known Element for Another To Obtain Predictable Results") described within the  
22 "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in

- 1 View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," 73
- 2 Fed. Reg. 57,526 (2007) (hereinafter "Examination Guidelines").

3

4 On the contrary, the Examiner appears to relied upon rationale G (i.e.,  
5 "Some Teaching, Suggestion, or Motivation in the Prior Art That Would Have Led  
6 One of Ordinary Skill To Modify the Prior Art Reference or To Combine Prior Art  
7 Reference Teachings To Arrive at the Claimed Invention"). As discussed in the  
8 Examination Guidelines, each rationale requires a different set of findings that  
9 must be articulated before a particular rationale can be employed. Since the  
10 analysis employed by the Honorable Board is completely different that that  
11 presented by the Examiner, Appellants have not had a fair opportunity to react to  
12 the thrust of the "affirmance" of the rejection.

13

14 As already argued above, the Honorable Board's has erred in asserting that  
15 the server would perform the same function that it has been known to perform,  
16 yielding expected results. The local data center is characterized as  
17 failed/unavailable, and thus, one skilled in the art would have recognized that the  
18 local data center is not capable of performing that same functions that the local  
19 data center was once capable of performing. Thus, the results of such a  
20 combination, as proposed by the Examiner, could not be expected with any

1 certainty. Therefore, the Honorable Board has not properly articulated the findings  
2 necessary to establish obviousness under rationale B within the Examination  
3 Guidelines.

4

5 A finding that the Honorable Board presumes, without basis, is that "the  
6 server [performs] the same function that it has been known to perform" and this  
7 function is that the local data center forwards a request to the remote data center.  
8 However, Helmer does not teach that the local data center, while available,  
9 forwards the request to the remote data center. Instead, as discussed on page 5 of  
10 the Reply Brief, Helmer teaches sending temporary data from the local data center  
11 to the remote data center. As such, the Honorable Board's finding that "the server  
12 [performs] the same function that it has been known to perform" is based upon  
13 speculation as to what the local data center "has been known to perform" and not  
14 based upon substantial evidence.

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17 On pages 8 and 9, under the heading "It Would Have Been Obvious to  
18 Combine the References," the Honorable Board proceeds to conclude that "[w]e  
19 find that a person of ordinary skill will be able to fit the teachings of Holmberg,  
20 Rizvi, and Helmer together like pieces of a puzzle since the person of ordinary skill

1 is also a person of ordinary creativity, not an automaton." However, the content of  
2 the Honorable Board's writings are either citations to case law or conclusory  
3 statements. The Honorable Board does not refer to any of the specific arguments  
4 made by either Appellants or the Examiner. Moreover, the Honorable Board  
5 doesn't explain, in any detail, why the claimed invention would have been obvious  
6 to one skilled in the art.

7

8 As noted by the Supreme Court, "rejections on obviousness grounds cannot  
9 be sustained by merely conclusory statements; instead there must be some  
10 articulated reasoning with some rational underpinning to support the legal  
11 conclusion of obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741  
12 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)). The Honorable  
13 Board's opinion, however, neither supplies this articulated reasoning or refers to  
14 the reasoning of the Examiner. Moreover, Appellants respectfully submit that the  
15 Honorable Board asks the wrong question. The question is not whether or not it  
16 would have been obvious to combine the applied prior art – Appellants' concede  
17 that it could have been obvious to combine the cited references. The question to be  
18 answered is whether the claimed invention would have been obvious based upon  
19 the combined teachings of the applied prior art. The fact the references can be

1 combined does not necessarily lead to the conclusion that the claimed invention  
2 would have been obvious.

3

4         By asserting that "a person of ordinary skill will be able to fit the teachings  
5 of [the applied prior art] together like pieces of a puzzle" while ignoring the  
6 requirement for some articulated reasoning with some rationale underpinning, the  
7 Honorable Board has presented a conclusion that is applicable to any combination  
8 of references that allegedly teach each limitation of any claimed invention. As  
9 noted by the Federal Circuit, "virtually all [inventions] are combinations of old  
10 elements." In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998)  
11 (quoting Environmental Designs, Ltd. v. Union Oil, 713 F.2d 693, 218 USPQ 865  
12 (Fed. Cir. 1993)). As such, to establish obviousness, there is still a need to set  
13 forth an analysis despite the applied prior art allegedly teaching all of the claimed  
14 limitations. Otherwise, "virtually all" inventions would be obvious.

15

16         On pages 6-8 of the Appeal Brief, Appellants presented arguments as to (i)  
17 the Examiner's failure to consider the claimed invention as a whole and (ii) the  
18 Examiner's failure to provide factual support for the Examiner's proposed  
19 motivation. These arguments were also continued on pages 3-7 of the Reply Brief.

1 However, the Honorable Board has not addressed, with any specificity, most of  
2 these arguments.

3

4 For example, the Honorable Board has not noted (or commented upon)  
5 Appellants' specific arguments that the Examiner's alleged motivation for the  
6 combination is factual unsupported and, in fact, leads away from the claimed  
7 invention (i.e., sending a request to the remote data center via the local data center  
8 is slower and less efficient than sending the message directly to the remote data  
9 center). This concept was also addressed in the paragraph spanning pages 1 and 2  
10 of the Reply Brief. Specifically, three references (Holmberg, Rizvi, and U.S.  
11 Patent No. 6,375,631, which was cited by Helmer) discuss using agencies (i.e., a  
12 device) outside the first application server (e.g., the redirector 16 of U.S. Patent  
13 No. 6,375,631, the client processor of Holmberg, or the client driver interface 204  
14 of Rizvi) to route the request to the second application (backup) server. Thus, the  
15 greater weight of evidence points to the first application server not forwarding the  
16 request. This evidence, however, does not appear to be given any weight by the  
17 Honorable Board. Instead, the Honorable Board appears to have thrown out this  
18 substantial evidence as to routing techniques that would lead away from the  
19 claimed invention and, instead, relied upon an alleged teaching within Helmer that  
20 was never explicitly set forth by Helmer.

1

2       Claims 7 and 11

3       Despite stating that claims 7 and 11 stand or fall separately from  
4 independent claim 1 on page 4 of the Appeal Brief and setting forth arguments as  
5 to these claims on pages 8 and 9 of the Appeal Brief and pages 8 and 9 of the  
6 Reply Brief, the Decision does not separately address these separately argued  
7 claims. As noted in Appellants' prior arguments, the Examiner's analysis lumps  
8 claims 7 and 11 together with claim 1. However, claims 7 and 11 recite different  
9 limitations than claim 1.

10

11       For example, claim 7 is directed to a device, whereas claim 1 is directed to a  
12 method. Therefore, the limitations cited in claim 7 are different than claim 1.  
13 Moreover, as discussed on pages 8 and 9 of the Reply Brief, claim 11 recites that  
14 the first application server forwards the response, which was received from the  
15 second application server, to the application client and this limitation is not  
16 contained in claim 1. On page 9 of the Reply Brief, Appellants further addressed  
17 with the applied prior art fails to teach these limitations. However, the Decision is  
18 completely silent as to these arguments. Thus, Appellants respectfully submit that  
19 the Honorable Board has overlooked these specific arguments.

20

1           For the reasons set forth in the Appeal Brief of November 22, 2006, and in  
2   the Reply Brief of August 14, 2007, and for those set forth herein, Appellants  
3   respectfully solicit the Honorable Board to reverse the Examiner's rejection under  
4   35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 24, 2008

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul  
Registration No. 42,984

Steven M. Greenberg  
Registration No. 44,725  
Phone: (561) 922-3845  
CUSTOMER NUMBER 46320